

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s) : Alan G. Barbour and Catherine J. Luke
U.S. Serial No. : 08/588,637
For : COMPOSITIONS AND METHODS FOR ADMINISTERING
BORRELIA BURGENDORFERI ANTIGENS
Filed : January 19, 1996
Examiner : R. Swartz
Group Art Unit : 1645

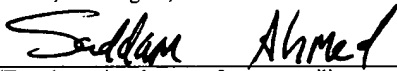
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REPLY TO SUPPLEMENTAL EXAMINER'S ANSWER

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231
Sir:

INTRODUCTION

This is an Appeal from the February 21, 2001 Final Rejection by the Examiner, and from the November 8, 2001 Advisory Action, finally rejecting claims 1-4, 6-10, 12 and 13, with an Appeal Brief having been filed in triplicate on February 20, 2002, the Examiner's Answer having been mailed August 7, 2002, a Reply Brief having been received at the USPTO on September 3, 2002 that contains Exhibits A-E and a showing under 37 CFR §1.195, a Communication issued December 23, 2002 stating that the Reply Brief had been entered and that the case would be

forwarded to the Board, a November 26, 2003 Remand To The Examiner, and a June 24, 2004 Supplemental Examiner's Answer. Oral argument has been requested.

This Brief is submitted in triplicate, and, the Commissioner is hereby authorized to charge any required fee for this Brief, or occasioned by this paper, or credit any overpayment in such a fee, to Deposit Account No. 50-0320.

RELIEF REQUESTED

It is respectfully requested that the rejection of claims 1-4, 6-10, 12 and 13 be reconsidered and withdrawn, and that a Notice of Allowance promptly issue.

STATUS OF THE CLAIMS

Claims 1-4, 6-10, 12 and 13 as set forth in Appendix A to the Appeal Brief, are rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claim 2 of U.S. Patent No. 5,688,512 ("the 512 patent") in view of Cohen, Immunization, in Basic & Clinical Immunology, 3rd ed. Fudenberg HH, Stites DP, Caldwell JL, Wells JV, ed. 1980 (Cohen).

ARGUMENT

THE REJECTION OF ALL CLAIMS UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING CANNOT STAND AND IS OVERCOME

I. *The Supplemental Examiner's Answer Is A Rehash of the Examiner's Answer And Fails To Comply With The Board's Directions In The Remand And Thus, The Rejection Should Be Reconsidered And Withdrawn For The Reasons Set Forth In The Brief and Reply Brief*

The Supplemental Examiner's Answer is merely a rehash of the Examiner's Answer and fails to comply with the directions in the Remand; and therefore, it is respectfully submitted that the rejection must be reconsidered and withdrawn for the reasons set forth in the Brief and the Reply Brief, which are hereby incorporated herein by reference.

1. *The Supplemental Examiner's Answer does not respond to the Reply Brief*

The Remand directed the Examiner "to prepare a substantive response *to each point contained in the Reply Brief, taking into account the exhibits*" (emphasis added).

The Supplemental Examiner's Answer does not respond to each point contained in the Reply Brief, taking into account the Exhibits, as called for in the Remand. Rather, the Supplemental Examiner's Answer is silent as to the Exhibits to the Reply Brief and does not address many portions of the Reply Brief, such as the text at pages 3-9 and 12-13 (e.g., sections

I.2, II.1, IV.1 of the Reply Brief). Accordingly, the Supplemental Examiner's Answer fails to respond to the Reply Brief and does not comply the Board's directions in the Remand.

Therefore, the rejection should be reconsidered and withdrawn.

2. The Supplemental Examiner's Answer fails to cite to any portion of Cohen

The Remand also called upon the Examiner to note that "*the examiner has not cited to specific sections of the Cohen reference* relied upon in the extant rejection" (emphasis added).

The Supplemental Examiner's Answer does not cite to any particular section in Cohen, but rather attempts to rely upon "Cohen ... *in toto*, to indicate and provide ... motivation/incentive for utilizing many different modes of administration."

Accordingly, the Supplemental Examiner's Answer fails to show how one skilled in the art would be motivated to arrive at the particular recitations of the claims on appeal from Cohen.

Indeed, the reliance on Cohen in the Supplemental Examiner's Answer "for ... many different modes of administration" shows that the Examiner HAS NO motivation, teaching, suggestion or incentive in the art to arrive at the particular recitations of the claims.

Therefore, the Supplemental Examiner's Answer fails to make out a *prima facie* case of obviousness, fails to respond to the Brief and Reply Brief (e.g., fails to reply to section II.1 of the Reply Brief), and thus fails to follow the directions of the Remand. Accordingly, the rejection should be reconsidered and withdrawn.

3. The Supplemental Examiner's Answer fails to substantively respond to each of Appellants' arguments for the separate patentability of the claims

The Remand called attention to the fact that Appellants "*present[ed] arguments for [the] separate patentability of [the] claims pending in this appeal,*" and that the Examiner previously failed to respond to the arguments directed to individual claims set forth in the briefing, *with the Examiner "requested [to provide a] substantive response ... to each argument made by [A]ppellants"* (underlining in original; italics emphasis added).

The Examiner's Supplemental Answer fails to address each of Appellants' arguments for the separate patentability of the claims. In fact, the Examiner's Supplemental Answer is silent as to the recitations of the claims on appeal and Appellants' arguments as to the individual patentability of each claim.

Accordingly, the Supplemental Examiner's Answer fails to follow the directions of the Remand, and fails to make out a case of obviousness of any of the claims. Therefore, the rejection should be reconsidered and withdrawn.

**4. The Supplemental Examiner's Answer is
merely a rehash of the Board-rejected Examiner's Answer**

The Supplemental Examiner's Answer is merely a rehash of the Board-rejected Examiner's Answer. For instance, attention is respectfully directed to the parallel text between the Board rejected Examiner's Answer and the Supplemental Examiner's Answer (*see, e.g.*, pages 5-6 of the Supplemental Examiner's Answer and page 5 of the Examiner's Answer), and to the failure of the Supplemental Examiner's Answer to comply with the directions set forth in the Remand, including as noted herein. Indeed, the Examiner's conclusory assertion at page 7 of the Supplemental Examiner's Answer, namely, that "[t]he motivation for the modification of claim 2 was put forth in the original rejection and the Examiner's answer" well illustrates that the Examiner has done little more than rehash the Board-rejected Examiner's Answer. That is, the Examiner still fails to supply a motivation for the modification of claim 2 of the 512 patent to arrive at each of the recitations of the claims, as argued in the Brief and Reply Brief; and therefore, the rejection should be reconsidered and withdrawn.

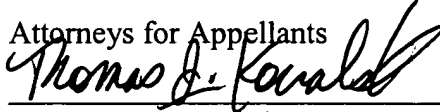
CONCLUSION

For the reasons discussed herein and in the Brief, and the Appeal Brief, and in the arguments of record (all of which incorporated herein by reference), claims 1-4, 6-10, 12 and 13 are patentable over claim 2 of the 512 patent, either individually or in combination with Cohen. It is, therefore, respectfully submitted that the Examiner erred in rejecting claims 1-4, 6-10, 12 and 13. A reversal of the rejection of claims 1-4, 6-10, 12 and 13 by this Honorable Board, and prompt issuance of a Notice of Allowance, are earnestly solicited.

Respectfully submitted,

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